REMARKS

This Reply is being filed in response to a final Official Action on a second Request for
Continued Examination (RCE). The Official Action continues to reject Claims 1, 6, 7, 9, 11-13,
17-20, 24-29 and 34-39 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No.
7,130,908 to Pecus et al., in view of U.S. Patent No. 6,157,982 to Deo. The Official Action then
continues to reject the remaining claims, namely Claims 2-5, 14-16, 21-23 and 30-33, as being
unpatentable over Pecus, in view of Deo, and further in view of U.S. Patent Application
Publication No. 2005/0172326 to Jerding et al. As explained below, however, Applicants
respectfully submit that the claimed invention is patentably distinct from Pecus, Deo and Jerding,
taken individually or in any proper combination. Applicants have amended various ones of the
claims to further clarify the claimed invention, replacing instances of "sending" to "directing
transmission of." Applicants submit that these amendments do not raise any new issues or
introduce any new matter, with at least the prior point of patentability remaining the same as
prior to amendment of the claims.

In view of the amendments to the claims and the remarks presented herein, Applicants
respectfully request reconsideration and allowance of all of the pending claims of the present
application. Alternatively, as neither the amendments nor remarks raise any new issues or
introduce any new matter, Applicants respectfully request entry of this Amendment for purposes
of narrowing the issues upon appeal.

A.   Claims 1, 6, 7, 9, 11-13, 17-20, 24-29 and 34-39 are Patentable

As indicated, the Official Action rejects Claims 1, 6, 7, 9, 11-13, 17-20, 24-29 and 34-39
as being unpatentable over Pecus, in view of Deo. As previously explained, in contrast to one
aspect of the claimed invention, as reflected by independent Claim 12, Pecus does not explicitly
or inherently (necessarily, if not explicitly) disclose an apparatus caused to <u>direct transmission of
a status of stored content to a remote apparatus, and receive instructions from the remote
apparatus based upon the status and parameters associated with the content including a client
expiration time and deletion priority value</u>. The final Official Action of this second RCE again
concedes that Pecus does not disclose the aforementioned feature, but maintains that Deo

discloses the feature and that it would have been obvious to one skilled in the art to modify Pecus per Deo to teach the apparatus of independent Claim 12. Applicants respectfully disagree, and maintain that even if one could argue Pecus and Deo disclose respective elements of independent Claim 12, there is no apparent reason for the combination of Pecus and Deo, and the Official Action does not provide sufficient reasoning for their combination.

As clearly explained by the Supreme Court in *KSR Int'l. Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 82 USPQ2d (BNA) 1385 (2007), any finding of obviousness should be based on an apparent reason to combine the prior art, and must be supported by more than mere conclusory statements. In the instant case, the Examiner includes the following explanation of Deo and the purported combination of Pecus and Deo:

> 17. ... *Deo discloses sending one or more instructions from a processor to a remote terminal based upon the status of the content stored in memory to at least partially control storage at least one piece of content in memory of the terminal, said instruction including determining available memory capacity of the terminal and if said memory does not have sufficient storage capacity deleting content (column 3, lines 8-24, a computer (apparatus) remotely issues memory transactions (instructions) to a information device (terminal), those instructions being based upon the content of the information device's memory, and the computer (apparatus) <u>determines how much space is available as it has a map of the device memory in its own memory</u>).*
>
> *Thus, the combined teachings of Pecus and Deo would yield a system in which the memory management method of Pecus executed by the edge node (i.e. determining what entries are expired and which are marked for deletion) would be carried out by the NOC. Due to the fact, that Deo discloses a system in which a remote device memory transactions are controlled by another, separate device.*
>
> *Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Pecus and Deo in order to decrease the processing burden of a terminal that has less processing power available than a computer it is networked with (Deo, column 2, line 65-column 3, line 4).*

Official Action of Nov. 24, 2009, pp. 9-10 (emphasis added). Applicants disagree with this assessment of Pecus and Deo insofar as the combination is alleged to teach the claimed invention.

1. *Pecus Fails to Disclose its Terminal having Less Processing Power*

As Applicants previously explained, even if the system of Deo does generally decrease the processing burden of a processing-limited terminal, the Official Action fails to make the connection between that general benefit of Deo and the particular system of Pecus. In this regard, the alleged benefit of Deo applies to processing-limited devices, but nowhere has the Official Action alleged or explained that the edge node (EN) of Pecus is a processing-limited device that would benefit from a reduction in its processing burden to the extent that it actually would have been obvious to one skilled in the art to modify Pecus as alleged.

In response, the Examiner in the final Official Action notes that the test for obviousness is not whether the features of a reference may be bodily incorporated into the structure of another reference, but instead, what the combined teachings of the references would have suggested to one skilled in the art. Official Action of Nov. 24, 2009, p. 3. Even given this proposition, however, Applicants submit that "[a] prior art reference must be considered in its entirety, i.e., <u>as a whole</u>, including portions that would lead away from the claimed invention." MPEP § 2141.02 (emphasis in original) (*citing W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). And considered as a whole, Pecus does not teach or suggest the type of processing-limited device to which Deo is directed, and therefore does not lend itself to the alleged motivation for modifying Pecus per Deo. In fact, the disclosure of Pecus in general clearly runs contrary to any suggestion that a reduction in the processing burden on its edge node is a concern that would lead one to modify the EN per Deo.

2. *Deo's Solution Leads Away from the Alleged Combination*

As previously explained, Deo discloses a system and method for remotely managing memory in a portable information device from an external computer. As disclosed, the device memory is mapped into a portion of the computer memory to create a virtual device memory therein. To effectuate a change in the device memory, then, a user enters programming changes to be made to the information device. The programming changes alter the virtual device memory within the computer memory, and a memory manager resident in the computer determines what memory transactions are effective to alter the virtual device memory. The computer generates a

serial stream of data indicative of memory transactions to effectuate a corresponding alteration of the device memory, and the data is transmitted to the information device to carry out the respective memory transactions and update the device memory.

As disclosed by Pecus its network operations center (NOC) may send a "RequestFileStatus" command to direct the edge node (EN) to provide the NOC with the status of locally-stored content, but the EN of Pecus makes decisions as to deleting content from its memory based on parameters including an expiration time and deletion priority value. In the system of Deo, on the other hand, the computer (analogous to the NOC of Pecus) makes decisions as to deleting content from memory of the portable information device (analogous to the EN of Pecus). Instead of making those decisions based on any notification of content status from the portable information device, however, the computer maps the device's memory; thereby negating any need for the computer receiving, from the portable information device, the status of content stored in memory of that device. The final Official Action even cites this feature of Deo in application of Deo to independent Claim 12. Official Action of Nov. 24, 2009, pp. 9-10 (explaining that "the computer (apparatus) determines how much space is available [on the portable information device] as it has a map of the device memory in its own memory").

At best, then, one could argue that Deo reduces processing burden on its portable information device by mapping memory of that device at the computer, and having the computer control storage of content in memory of that device. But by adding these features (mapping memory of the terminal and controlling storage of content) to the NOC (computer) of Pecus, the EN (portable information device) no longer needs to notify the NOC of the status of content in its memory since the server will already have that information. Thus, it would not have been obvious to one skilled in the art to modify Pecus per Deo to realize an apparatus that receives, from a remote terminal, a status of content stored in memory of the terminal, and that prepares one or more instructions for transmission to the terminal based on that status to thereby control storage of content in memory of the terminal, similar to independent Claim 12. Instead, at best one may argue that the combination of Pecus and Deo yields an apparatus that maps the memory of another apparatus, and sends instructions to the other apparatus based on the map (and not a received status from the apparatus).

In response, the Examiner in the final Official Action again notes that the test for obviousness is not whether the features of a reference may be bodily incorporated into the structure of another reference, but instead, what the combined teachings of the references would have suggested to one skilled in the art. Official Action of Nov. 24, 2009, p. 4. Considered <u>as a whole</u>, Deo's solution explicitly includes mapping the memory of a portable information device at a computer so as to reduce the memory management processing burden on the portable information device. And Applicants respectfully submit that the memory mapping feature of Deo may not be ignored when considering "what the combined teachings of the references would have suggested to one skilled in the art," particularly when this feature enables the benefit of modifying Pecus per Deo alleged in the Official Action.

Applicants therefore respectfully submit that amended independent Claim 12, and by dependency Claims 13-18, is patentably distinct from Pecus. Amended independent Claims 1, 19, 29 and 39 recite subject matter similar to that of independent Claim 12, including the aforementioned controlling storage of content at a terminal based on multiple parameters associated with the content, and sending instructions from a remote network entity or apparatus to control storage of such content. Thus, Applicants also respectfully submit that amended independent Claims 1, 19, 29 and 39, and by dependency Claims 2-7, 9, 11, 20-28 and 30-38, are also patentably distinct from Pecus, taken individually or in any proper combination, for at least the reasons given above with respect to independent Claim 12.

For at least the foregoing reasons, Applicants respectfully submit that the rejection of Claims 1, 6, 7, 9, 11-13, 17-20, 24-29 and 34-39 as being unpatentable over Pecus, in view of Deo is overcome. In addition to the foregoing reasons, Applicants respectfully submit that various ones of dependent Claims 2-7, 9, 11, 13-18, 20-28 and 30-38 recite features further patentably distinct from Pecus and Deo, taken individually or in any proper combination. Examples of such dependent claims, including Claims 7, 25 and 35, are explained below.

3. *Dependent Claims 7, 25 and 35*

As to dependent Claims 7, 25 and 35, neither Pecus nor Deo, taken individually or in any proper combination, teach or suggest <u>a server expiration time</u> according to which content may be

deleted from a network entity or apparatus (separate from the terminal with content associated with a client expiration time according to which locally-stored content may be deleted). The Official Action cites Pecus for allegedly disclosing this feature, with the Official Action alleging that the NOC of Pecus corresponds to the recited network entity. As previously explained, however, Applicants respectfully submit that nowhere does Pecus disclose its NOC monitors an expiration time (server expiration time) of its locally-stored content, and deletes content having an expired expiration time (server expiration time). Rather, Pecus only discloses deleting content locally-stored by its EN, and based upon a single expiration time (allegedly corresponding to the recited client expiration time). Thus, not only does Pecus not teach or suggest its alleged network entity deleting locally-stored content based upon monitoring an expiration time, Pecus does not teach or suggest multiple expiration times associated with a piece of content. That is, Pecus does not teach or suggest both a client expiration time (from which content may be deleted from memory of a terminal), and a server expiration time (from which content may be deleted from the network entity that sends the content to the terminal), as recited by dependent Claims 7, 25 and 35.

Applicants note that in response to the foregoing, the Examiner merely repeats the Examiner's same position from a prior Official Action. Other than stating disagreement with Applicants' arguments, nowhere does the Examiner provide any explanation as to any point of disagreement with Applicants' arguments, or provide any other indication that the Examiner considered Appellant's arguments. As has been held, however, "[i]f a *prima facie* case [of obviousness] is made in the first instance, and if the applicant comes forward with reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, the entire merits of the matter are to be reweighed." *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

B. *Claims 2-5, 14-16, 21-23 and 30-33 are Patentable*

The Official Action rejects Claims 2-5, 14-16, 21-23 and 30-33 as being unpatentable over Pecus, in view of Deo, and further in view of Jerding. As explained above, independent Claims 1, 12, 19, 29 and 39, and by dependency Claims 2-7, 9, 11, 13-18, 20-28 and 30-38, are patentably distinct from Pecus and Deo, taken individually or in any proper combination.

Applicants respectfully submit that Jerding does not cure the deficiencies of Pecus and Deo. That is, even considering Jerding, none of Pecus, Deo or Jerding, taken individually or in any proper combination, teaches or suggests the aforementioned controlling storage of content at an apparatus based on multiple parameters associated with the content, and sending instructions from another, remote apparatus to control storage of such content, as per independent Claims 1, 12, 19, 29 and 39. Applicants therefore respectfully submit that independent Claims 1, 12, 19, 29 and 39, and by dependency Claims 2-7, 9, 11, 13-18, 20-28 and 30-38, are patentably distinct from Pecus, in view of Deo, and further in view of Jerding.

For at least the foregoing reasons, Applicants submit that the rejection of Claims 2-5, 14-16, 21-23 and 30-33 as being unpatentable over Pecus, in view of Deo, and further in view of Jerding is overcome. In addition to the foregoing reasons, Applicants respectfully submit that various ones of dependent Claims 2-7, 9, 11, 13-18, 20-28 and 30-38 recite features further patentably distinct from Pecus and Deo, taken individually or in any proper combination. Examples of such dependent claims, including Claims 3-5, 14-16, 21-23 and 31-33, are explained below.

1. Dependent Claims 3, 4, 14, 15, 21, 22, 31 and 32

In contrast to dependent Claims 3, 14, 21 and 31, from which Claims 4, 15, 22 and 32 depend, nowhere does Pecus teach or suggest determining content having an exceeded client expiration time, and from that content, identifying content having the highest deletion priority value (thereby identifying content that is both expired and has the highest deletion priority value). That is, following the assertions in the Official Action, nowhere does Pecus teach or suggest determining expired content, and from that content, identifying content having the highest forced deletion flag (thereby identifying content that is both expired and has the highest forced deletion flag). Instead, Pecus treats its expiration time and forced deletion flag separate from one another in deciding whether to delete content. More particularly, Pecus discloses deleting all of the expired content or content marked for forced deletion; or first deleting content marked for forced deletion, and then expired content.

In response to the foregoing, the Examiner in the final Official Action states:

> 10. ... *Pecus and Deo discloses, as substantially recited in the claims,*
> *determining a plurality of pieces of content having an exceeded client*
> *expiration time (Pecus, column 17, lines 15-20, "expired files" are identified),*
> *identifying a piece of content having a highest deletion priority value from a*
> *comparison of the deletion priority values of the pieces of content having an*
> *exceeded client expiration time (column 17, lines 20-24, the data*
> *manager checks for file(s) marked for forced deletion; i.e. a plurality of files'*
> *forced deletion flag is compared with the Boolean value "true" to determine if*
> *they should be deleted, "true" being the highest value for deletion priority;*
> *further, as all files are checked those that are expired will also be checked), and*
> *send one or more instructions instructing the terminal to delete the*
> *identified piece of content (Pecus, column 17, lines 15-28, if files are both*
> *expired and have are marked for forced deletion, they will be deleted).*

Official Action of Nov. 24, 2009, pp. 5-6. As has been explained, however, even if one could

argue that the disclosed forced deletion flag of pieces of content of Pecus could correspond to the

recited deletion priority values of pieces of content, Pecus does not teach or suggest any

comparison between the flags of the pieces of content, similar to the deletion priority values of

Claims 3, 4, 14, 15, 21, 22, 31 and 32. The Examiner even concedes this point on page 15 of the

Official Action.

The Examiner appears to suggest that even if Pecus treats its expiration time and forced

deletion flag separate from one another in deciding whether to delete content, if content are both

expired and are marked for forced deletion – and are thus deleted, this meets the feature of

Claims 3, 4, 14, 15, 21, 22, 31 and 32. Applicants respectfully disagree and note that even if in

this limited circumstance the end result of the claimed invention and Pecus overlap, the claims

are not directed to the end result but instead the process by which that end result is achieved.

Thus, even if the end results overlap, Pecus still fails to disclose the process by which the end

result is achieved as recited by Claims 3, 4, 14, 15, 21, 22, 31 and 32.

2.   Dependent Claims 5, 16, 23 and 33

Dependent Claims 5, 16, 23 and 33, which depend from respective ones of Claims 3, 14,

21 and 31 by way of respective ones of Claims 4, 15, 22 and 32, recite sending or receiving

instruction(s) to delete content having an exceeded client expiration time, and from any

remaining content, delete content having the highest deletion priority value, which is also absent from Pecus, Deo and Jerding, taken individually or in any proper combination. Pecus does disclose deleting content marked for forced deletion (alleged deletion priority value), and then expired content (alleged exceeding client expiration time) – i.e., first forced deletion, then expired. But even given this disclosure, Pecus does not teach deleting expired content, and then content having the highest deletion priority – i.e., first expired, then highest deletion priority value, similar to Claims 5, 16, 23 and 33.
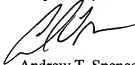
The Examiner in the final Official Action responds to the foregoing in a manner similar to the above response presented for Claims 3, 4, 14, 15, 21, 22, 31 and 32. Again, however, even if one could argue that the disclosed forced deletion flag of pieces of content of Pecus could correspond to the recited deletion priority values of pieces of content, Pecus does not teach or suggest any comparison between the flags of the pieces of content, also similar to the deletion priority values of Claims 5, 16, 23 and 33.

CONCLUSION

In view of the amendments to the claims and the remarks presented herein, Applicants respectfully submit that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicants' undersigned attorney in order to resolve any remaining issues. As explained above, no new matter or issues are raised by this Amendment, and as such, Applicants alternatively respectfully request entry of this Reply for purposes of narrowing the issues upon appeal.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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